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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,263	02/25/2002	Vincent P. Vaccarelli	D/A2038	4221

7590 12/23/2008
Patent Documentation Center
Xerox Corporation
Xerox Square 20th Floor
100 Clinton Ave. S.
Rochester, NY 14644

EXAMINER

WONG, ERIC TAK WAI

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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12/23/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/083,263

Applicant(s)

VACCARELLI ET AL.

Examiner

ERIC T. WONG

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 4-9, and 19-20 rejected under 35 U.S.C. 102(b) as being anticipated by Remedy (as evidenced by Newswire ("Remedy Introduces New Applications To The Customer Relationship Management (CRM) Market") and Strauss ("My Remedy what!? Has been resolved???"))

Examiner notes that the parts of the system which are recited in the claims are defined by functional language, ie. a query module for..., an analysis module for..., a reporting module for... Therefore, the language of the claims is given weight to the extent that the prior art is or is not capable of meeting the functional limitations. see *In Re Schreiber*, 128 F.3d 1473 (Fed. Cir. 1997).

Regarding claim 1,

Remedy contains a query module for automatically sending a query to a customer as to whether the customer has any problems with goods or services provided by a provider that have not been resolved to the customer's satisfaction according to a predetermined schedule (see Strauss, page 1, the generated email).

Examiner notes that Remedy sending a query to the customer after the customer has already opened a ticket qualifies as a predetermined schedule. Examiner also notes that Remedy sends the query to a customer after the customer has already opened a ticket rather than sending the query to a customer before the opening of a ticket. The references meet the limitations of the claim since the claim does not recite any required order. Even if the order was required, Bressler ("Internet CRM must have human touch") teaches contacting the customers to verify that everything is to their satisfaction prior to knowledge of a customer problem (see "Follow up").

Remedy receives responses from customers to the queries, wherein a query includes a user interface for receiving responses input from a customer. The user interface is e-mail, ie. Remedy directs the customer to e-mail a particular person or group (see Strauss, page 1 generated e-mail).

Remedy contains an analysis module for analyzing responses from customers to identify a customer problem, for sending the identified customer problem to a problem solver module for resolution by a problem solver, and for tracking status of the identified customer problem (see Strauss, page 2 paragraph 3). Remedy is configured to use e-mail as a means for submitting service tickets (see Newswire, page 2 paragraph 6) and automatically routes requests for support to the correct support personnel, ie. problem solver module (see Newswire, page 2 paragraph 3). Remedy also allows for tracking the status of the identified customer problem via the web (see Strauss, "Future Remedy capabilities for UNT customers" on page 5).

Remedy contains at least one problem solver module for receiving an identified customer problem from the analysis module, for transmitting the identified customer problem to a problem solver, for receiving a solution to the identified customer problem from the problem

solver, and for transmitting the solution to the customer (see Newswire, page 2 paragraphs 3 and 6).

Regarding claim 2,

Since Remedy sends queries, receives responses, identifies problems, and generates solutions, it MUST have a memory to store copies of each query sent, response received, problem identified and solution generated (the memory is at least random-access memory). Additionally, Remedy also stores this information in non-volatile memory in order to support generation of reports (see at least Strauss, page 2 sixth bullet point).

Regarding claim 4,

The query module sends queries via e-mail and receives responses via e-mail (see Newswire, page 2 paragraph 6).

Regarding claim 5,

Remedy teaches wherein the analysis module includes a pattern recognition system for analyzing customer responses. A pattern recognition system is inherent since Remedy automatically categorizes the type of problem based on analyzing customer responses.

Examiner additionally notes that Oatman (US Patent 5,778,157) teaches using a more specific type of pattern matching that may be more relevant to Applicant's invention. More specifically, Oatman teaches using natural language processing to analyze customer responses in order to identify a type of problem (see column 3 line 58-column 4 line 23).

Regarding claim 6,

Remedy includes a customer relationship management database (see Strauss, page 2 sixth bullet point). Remedy is a Customer Relationship Management solution (see Newswire) and therefore any database the system uses is a Customer Relationship Management database. Remedy further includes a problem reporting module (see Strauss "What Remedy is intended to do" on pages 1-2).

Regarding claim 7,

Remedy includes an account activity module including records of customer account activity for storing a record of customer queries, customer responses, customer problems and solutions (see Strauss "Future Remedy capabilities for UNT customers" on page 5).

Regarding claims 8 and 9,

Remedy follows up to determine that everything has been resolved to a customer's satisfaction (see Strauss, page 1 generated e-mail). The frequency of the follow-up, whether it be once a month or once a week, bears no patentable distinction.

Regarding claims 19 and 20,

Remedy is configured to close the identified customer problem responsive to a response from the customer verifying that the problem has been solved to the customer's satisfaction and open a new customer problem responsive to a response from the customer that the problem has not been solved. In particular, Remedy allows customers to "Check the status of their own trouble tickets, close them once they have been resolved, and reopen them if they have not really been resolved" (see Strauss "Future Remedy capabilities for UNT customers" on page 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Remedy.

Regarding claim 3,

As described above, Remedy is configured to send queries, receive responses, identify problems, and generate solutions. At the time of invention, Remedy also contained a report generator module (as evidenced by Ungil, "User interface" on page 2). It is not explicitly stated that the report generator module generates reports of queries sent, responses received, problems identified, and solutions generated. However, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Remedy to generate these specific reports since these reports contain information describing some of the main functions of the system. One skilled in the art would have been motivated to make the modification in order to provide useful metrics in measuring the quality of the system in providing problem resolution.

Examiner notes that while the date of the Ungil reference itself is not prior to the filing date of the application, the reference describes Remedy Action Request System 5.0, which was released in December 2001 (see "Conclusion" on page 4).

4. Claim 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Remedy in view of Official Notice.

Regarding claim 21,

Remedy allows customers via the web to "Check the status of their own trouble tickets, close them once they have been resolved, and reopen them if they have not really been resolved" (see Strauss "Future Remedy capabilities for UNT customers" on page 5). Remedy is further configured to communicate via e-mail to check whether or not a customer has an unresolved problem.

Remedy teaches querying whether a customer has any problems with goods or services provided by a provider that have not been resolved to the customer's satisfaction. Remedy does not explicitly teach a "yes" and "no" link enabling a response from the customer. Official Notice is taken that "yes" and "no" hyperlinks enabling a response were old and well known at the time of invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Remedy with a yes link for enabling a customer to respond in the affirmative and a no link for enabling a customer to respond in the negative. One skilled in the art would have been motivated to make the modification to facilitate, in a convenient manner, the process in which Remedy ensures that the problem was actually resolved.

In support of the Official Notice, Examiner provides Gusick(US PG-Pub 2001/0047270 A1). Gusick provides an e-mail with a "yes" or "no" link in which an expert may respond to a query in the affirmative, wherein responsive to selection of the yes link, the system displays an interface for receiving input from the expert (see paragraph 75 and 76).

Response to Arguments

5. Applicant's arguments filed 11/12/2008 have been fully considered but they are not persuasive.
6. Applicant's argues: 1) The Examiner improperly uses two references (Newswire and Strauss) in making a rejection under 35 USC 102. MPEP 2131.01. Newswire and Strauss were published on different dates.

The argument is not found persuasive because the claims were rejected as being anticipated by Remedy as opposed to the non-patent literature, which serve as supporting evidence of the features of Remedy. Both references, although published on different dates, serve as evidence that Remedy Action Request System **was in public use or on sale in this country** more than one year prior to the date of application for patent in the United States (see 35 U.S.C. 102(b)).

According to MPEP 2131.01 a 35 USC 102 rejection over multiple references has been held to be proper when the extra references are cited to:

- (A) Prove the primary reference contains an "enabled disclosure";
- (B) Explain the meaning of a term used in the primary reference; or
- (C) Show that a characteristic not disclosed in the reference is inherent.

The references were cited to show that a characteristic not disclosed in the reference is inherent, ie. if the software exists, then the characteristics of that software are inherent to the software. Examiner reminds Applicant that the standard to be applied in all cases by the examiner is the "preponderance of the evidence" test. In other words, an examiner should reject

a claim if, in view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable (see MPEP 706).

7. Applicant argues: 2) Parts of Applicants' system recited in the claims are not defined by functional language.

Examiner disagrees and maintains that language found in the claim such as "query module", "reporting module", and "analysis module" constitutes functional language and should be given weight to the extent the prior art is or is not capable of meeting the functional limitations. A module does not necessarily define structure since it may be reasonably interpreted as a software component. If applicant believes that the modules recited in the claims define the system structurally, applicant is requested to point out, in the specification, the structure that corresponds to each module claimed.

8. Applicant argues: 3) Bressler is not available as a reference under 35 USC 102(b) against the Application.

The argument is moot since Bressler was not cited in the statement of rejection. Instead, Bressler was provided to applicant as a reference which may be reasonably pertinent to the invention.

9. Applicant argues: 4) Both Bressler and Oatman are improperly cited in the Examiner's rejection under 35 USC 102(b).

The argument is moot since neither Bressler nor Oatman was cited in the statement of rejection. Instead, both Bressler and Oatman were provided to applicant as references which may be reasonably pertinent to the invention.

10. 5) Claims 1-9 and 19-20 are not obvious under 35 USC 103(a) over Newswire, "Remedy Introduces New Applications to the Customer Relationship Management (CRM) Market" or Strauss ("My Remedy what!? Has Been Resolved???"), whether taken alone or in combination.

Regarding claims 1-2 and 19-20, the argument is moot since the claims are rejected under 35 USC 102(b) and not under 35 USC 103(a).

Regarding claim 3, Applicant has not provided any reasoning as to why Applicant believes the claim is not obvious under 103(a). As such, the argument amounts to a general allegation that the claim defines a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

11. Applicant argues: 6) Neither Strauss nor Newswire sends open ended queries to users. Neither Strauss nor Newswire sends "a query to a customer as to whether the customer has any problems with goods or services provided by a provider that have not been resolved to the customer's satisfaction.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., open-ended queries) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that neither Strauss nor Newswire teaches a query module for "sending a query to a customer as to whether the customer has any problems with goods or services provided by a provider that have not been resolved to the customer's satisfaction". The argument is not persuasive because Strauss demonstrates that Remedy sends a query to a customer as to whether the customer has any problems with goods or services provided by a provider that have not been resolved to the customer's satisfaction. An email inquiry from Strauss is reproduced in part below:

"If the problem was NOT resolved, please contact (group/person) <a group name or acronym you have never heard of / a computer support person you think you might have talked to on the phone once, and a phone number that may look familiar>."

As shown above, Remedy does, in fact, send a query to a customer as to whether the customer has any problems with goods or services provided by a provider that have not been resolved to the customer's satisfaction.

12. Applicant argues that 7) Neither Newswire nor Strauss discloses an email query including a yes link and a no link.

Applicant argues that the Official Notice taken that yes/no hyperlinks were old and well known in the art at the time of invention does not teach or suggest Applicant's claim 21. Examiner disagrees respectfully. Remedy teaches querying whether a customer has any problems with goods or services provided by a provider that have not been resolved to the customer's satisfaction. Remedy does not explicitly teach a "yes" and "no" link enabling a response from the customer. Official Notice is taken that "yes" and "no" hyperlinks enabling a response were old and well known at the time of invention. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Remedy with a "yes" link for enabling a customer to respond in the affirmative and a "no" link for enabling a customer to respond in the negative.

In support of the Official Notice, Examiner provides Gusick(US PG-Pub 2001/0047270 A1). Gusick provides an e-mail with a "yes" or "no" link in which an expert may respond to a query in the affirmative, wherein responsive to selection of the yes link, the system displays an interface for receiving input from the expert (see paragraphs 75 and 76).

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC T. WONG whose telephone number is 571-270-3405. The examiner can normally be reached on Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

ERIC T. WONG
Examiner
Art Unit 3693

December 8, 2008